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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/766,730	01/22/2001	Claudio L.K. Lins	6289	1305

22922 7590 09/25/2006

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EXAMINER

CHORBAJI, MONZER R

ART UNIT PAPER NUMBER

1744

DATE MAILED: 09/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action  
Before the Filing of an Appeal Brief**

Application No.

09/766,730

Examiner

MONZER R. CHORBAJI

Applicant(s)

LINS, CLAUDIO L.K.

Art Unit

1744

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 11 September 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.

6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 1-27.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).


10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.

12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_

13. ☐ Other: \_\_\_\_\_.

  
**WILLIAM H. BEISNER**  
PRIMARY EXAMINER  
GROUP 1744

Continuation of 5. Applicant's reply has overcome the following rejection(s): The 112, paragraph I, new matter with regard to independent claim 9.

Continuation of 11. does NOT place the application in condition for allowance because: Response to Arguments

On page 10 of the Remarks section; applicant argues that, "the examiner has misread the boiler plate statements in Rabe that all combinations of such embodiments and features are possible to mean all combinations of the components of the embodiments are possible. The language in Rabe does not teach that essential elements of the embodiments may be removed from or absent from the embodiments of the disclosed compositions." Column 2, lines 55-58 of Rabe conveys to one of ordinary skill in the art that Rabe discloses multiple embodiments where each embodiment has certain combination of elements within it (col.2, lines 9-24 and col. 8-11). All various combinations of including or excluding various elements are possible. The word combination would convey to one of ordinary skill in the art that for a certain embodiment, the combination is, for example, a, b, c, d and optional components (columns 8-11). Another possible combination that falls within the teaching scope of Rabe is a, b and d. This combination does not include insoluble and immiscible particulate material. The word combination does mean to add or remove any component provided in Rabe disclosure. In addition, under the heading "Optional Components" in col.8, line 51 and turning to col.9, lines 1-10, particulate materials, which are not soluble or miscible are listed. Clearly, reading the entire disclosure of Rabe, particulate materials are considered optional components.

On page 10 of the Remarks section; applicant argues that, "The summary of the invention section specifically requires this component (col.2, lines 21-22). The detailed description of the invention section specifically requires this component (col.3, lines 30-31)". The examiner disagrees with Applicant characterization of the two teachings that both must include particulate material since the disclosed embodiments are illustrations of the possible outcomes of various combinations of the components of Rabe compositions. In both embodiments particulate material is used where as in other embodiments, particulate material is not required. Furthermore; as disclosed above Rabe considers particulate material as an optional component. Thus, based on the entire disclosure of Rabe, one combination has all components being soluble and/or miscible.

On page 10 of the Remarks section; applicant argues that, "By stating that the compositions also comprise the particulate matter, Rabe teaches that the compositions must include the particulate matter." Again, the examiner disagrees with Applicant characterization of this individual teaching for a one embodiment that the total disclosure of Rabe requires every embodiment to include particulate material. This disclosed embodiment is an illustration of the possible outcomes of the various combinations of the components of Rabe compositions. In this embodiment particulate material is used where as in other embodiments, particulate material is not required. Furthermore; as disclosed above Rabe considers particulate material as an optional component.